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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,655	07/27/2004	Glenn A. Cowelchuk	MASL-46	4654

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EXAMINER
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ENGLE, PATRICIA LYNN

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/710,655

Applicant(s)

COWELCHUK ET AL.

Examiner

Patricia L. Engle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to a trim assembly, classified in class 296, subclass 146.7.
  - II. Claims 13-20, drawn to a method of forming a trim, classified in class 264, subclass 255.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process (two shot molding is not required by the product claims) and the process can make another product (a front surface facing a vehicle interior is not required of the process claims).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Steve Benintendi on October 21, 2005 a provisional election was made without traverse to prosecute the invention of the trim assembly, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102/103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 2, 7 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murakami et al. (US 2002/0113460).

Regarding claim 1, Murakami et al. disclose an automotive interior trim assembly for coupling to an automobile, comprising: a substrate member (12) forming at least a part of a structural support of the trim assembly, said substrate member (12) having a front surface (12a) adapted to face the interior of the automobile and a back surface adapted to face opposite said front surface; a connecting member (12b) integrally molded with said substrate member and extending away from said back surface (Fig. 3), said connecting member (12b) having an aperture (Fig. 3) formed therein; and a grommet (7a) integrally molded in said aperture and adapted to secure a wire (2c) to said connecting member (12b) so as to prevent movement of the wire with respect to said substrate member (12). MPEP 2113 Product-by-Process Claims states that "If the product in the product-by-process claim is that same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." The trim panel with a grommet is anticipated by Murakami et al. The process by which the grommet is made is not a patentable distinction.

Regarding claim 2, Murakami et al. disclose the trim assembly of claim 1, wherein said substrate member (12) has a hardness and said grommet (7a) has a hardness that is relatively lower than the hardness of said substrate member. Although Murakami et al. do not specifically disclose that the grommet material has a lower hardness than the substrate member, the

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Examiner takes Official Notice that grommets are made of flexible material which allows the wires to move through them and to move around whereas the substrate member is made of a hard material in order to support the elements mounted on the substrate and to provide a stiff door panel.

Regarding claim 7, Murakami et al. discloses the trim assembly of claim 1, wherein said connecting member (12b) completely encapsulates said aperture (Fig. 3).

Regarding claim 12, Murakami et al. discloses the trim assembly of claim 1 configured as a door panel for an automobile.

10. Claims 3-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al.

Regarding claim 3, Murakami et al. disclose the trim assembly of claim 1. Murakami et al. do not disclose a cover member overlying at least a portion of said front surface and adapted to provide a soft feel to the trim assembly, said cover member having a hardness that is relatively lower than a hardness of said substrate member. The Examiner takes Official Notice that covers on door panel substrate members are well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a cover on the substrate. The motivation would have been to provide an aesthetically pleasing door panel.

Regarding claims 4, 5 and 6, Murakami et al. disclose the trim assembly of claim 1. Murakami et al. do not disclose that the substrate member is formed from a material selected from the group consisting of thermoplastic olefin, acrylonitrile butadiene styrene, styrene maleic anhydride, and polycarbonate/acrylonitrile butadiene styrene alloy; or that the grommet is formed from thermoplastic elastomer. It would have been obvious to one of ordinary skill in the

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art at the time of the invention to use one of the listed materials for the substrate member, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use.

Regarding claim 11, Murakami et al. discloses the trim assembly of claim 1. Murakami et al. do not disclose that the substrate is configured as an instrument panel for an automobile. It would have been obvious to one of ordinary skill in the art at the time of the invention to configure a substrate to be an instrument panel with a connecting member and a grommet in an aperture in the connecting member. The motivation would have been to hold the wiring for an instrument panel adjacent to the instrument panel substrate.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. in view of Kobrehel (US 5,927,020).

Murakami et al. disclose the trim assembly of claim 1.

Murakami et al. do not disclose that the aperture includes a slot portion wherein the wire is insertable in the slot.

Kobrehel discloses a trim assembly with a projection (Fig. 3) which includes a slot that the wire is inserted through.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a slot in the projection to insert the wiring through. The motivation would have been to allow the wire to be easily removed and reinstalled. A natural result of the slot would be a grommet with a slot (Fig. 9). The motivation for the grommet slot would be to install the wiring.

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12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. in view of Kobrehel as applied to claims 8 and 9 above, and further in view of Marroquin et al. (US Patent 6,953,897 filed on Aug. 21, 2003).

Murakami et al. as modified disclose the trim assembly of claim 9.

Murakami et al. as modified do not disclose that the grommet includes two perpendicular slits.

Marroquin et al. disclose a grommet with perpendicular slits which allow the item supported by the grommet to be inserted and the grommet to flex to the size of the item.

### *Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art discloses other vehicle trim panels and other grommets for wiring harnesses.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Engle whose telephone number is (571) 272-6660. The examiner can normally be reached on Monday - Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L Engle  
Primary Examiner  
Art Unit 3612

ple  
October 26, 2005